

ay



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,667	01/24/2001	Takeo Hoda	05058/02806	4380

24367 7590 05/20/2005

SIDLEY AUSTIN BROWN & WOOD LLP
717 NORTH HARWOOD
SUITE 3400
DALLAS, TX 75201

EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
----------	--------------

2616

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,667

Applicant(s)

HODA ET AL.

Examiner

HUY T. NGUYEN

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42,44-50 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42,44-50 and 52-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 42 and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tojo et al (5,737,014 in view of Kinoshita et al ((4,897,732).

Regarding claims Tojo discloses a camera having a recording/reproducing apparatus (Figs. 1,3) reproducing the images signal . The apparatus comprises:

- a first storing means (20) for storing a plurality of images column 2, lines 61-65);
- a second memory (7) for storing a plurality of images;

Art Unit: 2616

a reproducing means for reproducing the image signals from the first memory and the image signal from the second memory ; and

a changer means (40,38,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 18, lines 17-26, column 7, lines 14-20).

Tojo further reaches that the first memory is detachable but fails to teach that the second memory is fixedly installed in the camera . Kinoshita teaches a camera having a first memory detachable from the camera and a second memory that is fixedly installed in the camera (Fig. 4) .

It would have been obvious to one of ordinary skill in the art to modify Tojo with Kinoshita by using the teaching of Kinoshita for fixedly installing the second memory in the camera as an alternative method of installing the second memory in the camera .

Tojo further teaches that the image pick up apparatus having body and the recorder 2 can be attached and combined with the image pickup apparatus to form a camera having a body that covers the first memory and second memory (column 9, lines 21-45).

In Remarks, applicant argues that the first memory is not detachable and install inside the body of the camera since the first memory is attaches to the camera when needed . In response, the examiner disagrees . It is noted that at column 2, lines 50-55, Tojo teaches that the camera comprises a imager 1 and recorder 2 and when the recorder 2 is attached to the image 1 the body of the camera that formed by body of

Art Unit: 2616

imager 1 and recorder 2 covers the first memory and the first memory is inside the camera body.

3. Claims 50 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tojo et al in view of Kinoshita as applied to claims 42 and 44-49 above, further in view of Pfeiler et al (4,709,385) .

Regarding claims 50 and 52-55, Tojo discloses a recording/reproducing apparatus (Fig. 1) reproducing the images signal . The apparatus comprises:

a first storing means (7) installed inside the camera body for storing a plurality of images column 2, lines 61-65);

a second memory (20) installed inside the camera body for storing a plurality of images;

a reproducing means having electrical connections to the first storing memory and second memory for reproducing the image signals from the first memory and the image signal from the second memory ; and

a changer means (40,38,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 18, lines 17-26, column 7, lines 14-20).

Tojo fails to teach the use of a buffer memory for storing the image from the first memory or second memory Pfeiler teaches an apparatus having a memory receiving the images from one of two memories (8,9) (Fig. 1, image memory 12) via electrical connections . Therefore, it would have been obvious to one of ordinary skill in

Art Unit: 2616

the art to modify Tojo by using a memory as taught by Pfeiler for storing the image signals from the first memory or second memory in order to easily control the timing of the image signal to be output to another device.

Applicants argue that there is no motivation for combining Tojo and Pfeiler since Tojo teaches a camera and Pfeiler teach x-ray apparatus. In response, the examiner disagrees. It is submitted that both Tojo and Pfeiler teach using memories for storing the images and that using a buffer for easily managing the timing of outputting the images from a memory is well recognized in the art and taught by Pfeiler. The examiner uses Pfeiler reference as evidence that a buffer can be used for storing the outputs of the memories. One wants to easily control the outputs of the first memory and second memory of Tojo will use the teaching of Pfeiler for installing a buffer for receiving the images from the first memory and second memory of Tojo camera. Managing the timing of the images is motivation for combining Tojo and Pfeiler. Further, it is noted that claims do not specify how to use a buffer to control, store and output the images from the first memory and second memory that is different from using the buffer in the prior art. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

Art Unit: 2616

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

4. Claims 42 and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taka (5,162,833) in view of Sasaki et al (5,034,804).

Regarding claims 42- 43 and 44-49, Taka discloses a camera having a body recording/reproducing apparatus (Fig. 1, column) for recording and reproducing the image signal . The apparatus comprises:

a first storing means (10) installed inside the camera body for storing a plurality of images (column 3, lines 53-65) column 2, lines 61-65) ;

a second memory (12) installed inside the camera body for storing a plurality of images;

a reproducing means (14,16) for reproducing the image signals from the first memory and the image signal from the second memory ; and

a changer means (40,38,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 8, lines 38-42, column 12, lines 55-60).

Taka teaches first memory and second memory are installed in the camera body since , at columns 3 and 4, Figs. 1 and 2 , Taka teaches the internal circuits inside the camera including the first memory and second memory and buttons mount on camera body used for operating the first memory and second memory .

Taka fails to specifically teach that the first memory is detachable from the camera body . However, it is not that using detachable memory for storing the images is well known in the art as taught by Sasaki . Therefore, it would have been obvious to one of ordinary skill in the art to modify Taka with Sasaki by using a detachable memory as an alternative to the first memory of Taka for storing the images in order to easily replace or use or reuse the first memory when needed.

Applicants argue that there is no motivation or suggestion for using the second memory as a removable memory . In response the examiner disagrees . It is noted that choosing a fixedly installed memory or irremovably installed memory is well known in the art at the time the invention was made . The prior art teaches that using removable memory will make replacing the memory more easily from the fixed memory therefore one wants to easily replace a memory will using a removable memory and one do want a memory to be easily replaced they will choose a fixedly installing memory. Therefore the motivation for using the first memory as removable is that providing more convenience to the user when the first memory needed to be replaced .

5. Claims 50 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taka (5,162,833) in view of Sasaki et al (5,034,804) and Pfeiler et al (4,709,385).

Regarding claims 50 and 52-55, Taka discloses a camera having a recording/reproducing apparatus (Fig. 1) for recording and reproducing the image signal. The apparatus comprises:

- a first storing means (10) installed inside the camera body for storing a plurality of images (column 3, lines 53-65)column 2, lines 61-65) ;

- a second memory (12) installed inside the camera body for storing a plurality of images;

- a reproducing means (14,16) for reproducing the image signals from the first memory and the image signal from the second memory ; and

- a changer means (40,38,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 8, lines 38-42, column 12, lines 55-60).

Taka teaches first memory and second memory are installed in the camera body since , at columns 3 and 4, Figs. 1 and 2 , Taka teaches the internal circuits inside the camera including the first memory and second memory and buttons mount on camera body used for operating the first memory and second memory .

Taka fails to specifically teach that the first memory is detachable from the camera body . However, it is not that using detachable memory for storing the images is well known in the art as taught by Sasaki . Therefore, it would have been obvious to one of ordinary skill in the art to modify Taka with Sasaki by using a detachable memory as an alternative to the first memory of Taka for storing the images in order to easily replace or use or reuse the first memory when needed.

Art Unit: 2616

Taka fails to teach the use a memory for receiving the images from the first memory or second memory.

Pfeiler discloses an apparatus for reproducing the image having a memory (12) for receiving the image signal to be reproduced on a display from one of two other memories via electrical connections (8 and 9).

It would have been obvious to one of ordinary skill in the art to modify Taka with Pfeiler by using a memory as taught by Pfeiler for receiving the image from the first or second memory in order to easily control the timing of the image to be reproduced on a display.

Applicants argue that there is no motivation for combining Taka and Pfeiler since Taka teaches a camera and Pfeiler teach x-ray apparatus. In response, the examiner disagrees. It is submitted that both Taka and Pfeiler teach using memories for storing the images and that using a buffer for easily managing the timing of outputting the images from a memory is well recognized in the art and taught by Pfeiler. The examiner uses Pfeiler reference as evidence that a buffer can be used for storing the outputs of the memories. One wants to easily control the outputs of the first memory and second memory of Taka will use the teaching of Pfeiler for installing a buffer for receiving the images from the first memory and second memory of Taka camera. Managing the timing of the images is motivation for combining Taka and Pfeiler. Further, it is noted that claims do not specify how to use a buffer to control, store and output the images from the first memory and second memory that is different from using the buffer in the prior art. In response to applicant's argument

Art Unit: 2616

that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

6. Claims 42 and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konishita et al (4,897,732) in view of Takahashi (5,067,029).

Regarding claims Konishita discloses a camera having a recording/reproducing apparatus (Fig. 1,3 column 3-4) for reproducing the images signals from the memories of the camera. The apparatus comprises:

- a first storing means (20) for storing a plurality of images (column 2, lines 61-65);

- a second memory (7) for storing a plurality of images (column 4, lines 60-65);

- a reproducing means for reproducing the image signals from the first memory and the image signal from the second memory (column 3, lines 1-10 lines 60-68); and

- a changer means (14,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively (column 18, lines 17-26, column 7, lines 14-20).

Kinoshita further teaches that the first memory is detachable and second memory is fixed (Fig. 4). Kinoshita fails to specifically teach that the first memory is installed inside the body of the camera. Takahashi teaches a camera that having first memory and a second memory for storing the images, the second memory is detachable and inside the body of the camera (column 10, lines 29-40, Fig. 10) as an alternative arrangement of the second memory for the camera. Therefore, it would have been obvious to one of ordinary skill in the art to modify Kinoshita with Takahashi by using the teaching of Takahashi for mod the camera body of Kinoshita and the first memory and to arrange the first memory to be detachable and is inside the body of the camera as an alternative arrangement of the first memory for the camera.

Applicant argues that there is no suggestion in the Kinoshita and Takahashi to combine Kinoshita with Takahashi. In response, the examiner disagrees. It is noted that Kinoshita at column 5, lines 50-50 teaches the memory 2 (first memory) can be attached to the imager (camera) when needed for recording a number of frames of images that more than the capacity of the first memory can handle. It is clear that Kinoshita teaches suggestion for using two memories for a camera and the first memory can attached to the camera body. Therefore the combination of Kinoshita and Takahashi is suggested by both Kinoshita and Takahashi and not against to the teaching of Kinoshita. Generally, using a fixedly or removable installed memory for storing the images in a camera is merely called for choosing the well known kinds of the memory for storing the images and that being applied by applicants.

Art Unit: 2616

7. Claims 50 and 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konishita et al (4,897,732) in view of Takahashi (5,067,029) and Pfeiler et al (4,709,385).

Regarding claims 50 and 52-55, Konishita discloses a camera having a recording/reproducing apparatus (Fig. 1, column 3-4) for reproducing the image signals from the memories of the camera. The apparatus comprises:

- a first storing means (20) for storing a plurality of images (column 3);
- a second memory (7) for storing a plurality of images (column 4, lines 60-65);
- a reproducing means for reproducing the image signals from the first memory and the image signal from the second memory (column 3, lines 1-10 lines 60-68); and
- a changer means (14,11) for selecting a reproduction of either the image signals from the first memory or second memory in accordance with a first condition or second condition respectively.

Kinoshita further teaches that the first memory is detachable and second memory is fixed. Kinoshita fails to specifically teach that is installed inside the body of the camera.

Takahashi teaches a camera that having first memory and a second memory, wherein the second memory can be detached and is inside the camera body (column 10, lines 29-40, Fig. 10) as an alternative arrangement of the second memory. Therefore, it would have been obvious to one of ordinary skill in the art to modify Kinoshita with Takahashi by using the teaching of Takahashi for modify the camera

Art Unit: 2616

body of Kinoshita to arrange the first memory to be detachable from the camera body as an alternative arrangement of the first memory

Kinoshita fails to teach the use of a buffer memory for storing the image from the first memory or second memory. Pfeiler teaches a camera having a memory receiving the images from one of two memories (8,9) (Fig. 1, image memory 12) via electrical connections. Therefore, it would have been obvious to one of ordinary skill in the art to modify Kinoshita by using a memory as taught by Pfeiler for storing the image signals from the first memory or second memory in order to easily control the timing of the image signal to be output to another device.

Applicants argue that there is no motivation for combining Kinoshita and Pfeiler since Kinoshita teaches a camera and Pfeiler teach x-ray apparatus. In response, the examiner disagrees. It is submitted that both Kinoshita and Pfeiler teaches using memories for storing the images and that using a buffer for easily managing the timing of outputting the images from a memory is well recognized in the art and taught by Pfeiler. The examiner using Pfeiler reference as evidence that a buffer can be used for storing the outputs of the memories. One want to easily control the outputs of the first memory and second memory of Kinoshita will use the teaching of Pfeiler for installing a buffer for receiving the images from the first memory and second memory of Kinoshita camera. Managing the timing of the images is motivation for combining Kinoshita and Pfeiler. Further, It is noted that claims do not specify how to use a buffer to control, store and output the images from the first memory and second memory that is different from using the buffer in

Art Unit: 2616

the prior art . In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Response to Arguments

8. Applicant's arguments filed 06 December 2004 have been fully considered but they are not persuasive. See examiner argument above .

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2616

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N


HUY NGUYEN
PRIMARY EXAMINER